

REMARKS

1. Claim Rejection - 35 U.S.C. §112 – Claim 15

Claim 15 is pending in the present application and was objected to in the Office action dated July 14, 2003 under 35 U.S.C. § 112, as containing an informality in grammatical form. Applicant respectfully traverses this rejection. However, claim 15 has been deleted. Thus, Applicant submits that the 35 U.S.C. § 112 objection to claim 15 is now moot.

2. Claims Rejections - 35 U.S.C. §102(b) – Claims 5-9 and 15-16

Claims 5-9 and 15-16 are pending in the present application and were rejected in the Office action dated July 14, 2003 under 35 U.S.C. § 102(b), as being anticipated by Kundu et al. (TEM-Mode Planar Dielectric Waveguide resonator BPF for W-CDMA). Applicant respectfully traverses this rejection. However, claims 5-9 and 15-16 have been deleted. Thus, Applicant submits that the 35 U.S.C. § 102(b) rejection to claims 5-9 and 15-16 is now moot.

3. Claims Rejections - 35 U.S.C. §103(a) – Claims 1-4 and 11-13

Claims 1-4 and 11-13 are pending in the present application and were rejected in the Office action dated July 14, 2003 under 35 U.S.C. § 103(a), as being unpatentable over Kundu et al. (TEM-Mode Planar Dielectric Waveguide resonator BPF for W-CDMA) in view of Konishi (Novel Dielectric Waveguide Components-Microwave Applications of New Ceramic Materials). Applicant respectfully traverses this rejection. However, claims 1-4 and 11-13 have been deleted. Thus, Applicant submits that the 35 U.S.C. § 103(a) rejection to claims 1-4 and 11-13 is now moot.

4. New claims 17-21

Claims 17-21 were added in response to the Office action of July 14, 2003. No new matter has been added. Claim 17 is an independent claim. Claims 18-21 depend, either directly or ultimately, from independent claim 17. For brevity, only independent claim 17 is discussed below in relation to Kundu et al. and Konishi, based upon the understanding that dependent

claims 18-21 are also patentably distinct over the prior art as they depend from claim 17. In any case, dependent claims 18-21 include additional features that, in combination with those of claim 17, provide further, separate, and independent bases for patentability.

Applicant herein compares and contrasts the Kundu et al. reference and the Konishi reference with the claimed invention of the present application, as recited in new claims 17-21. The Kundu et al. reference discloses a band pass filter comprising two quarter-wave ($\lambda/4$) resonators and an evanescent H-mode waveguide. In contrast, the band pass filter recited in the claimed invention comprises two half-wave ($\lambda/2$) resonators and an evanescent E-mode waveguide disposed therebetween. Therefore, it is clear that the band pass filter disclosed in Kundu et al. and the claimed band pass filter are patentably distinct in both configuration and operation.

Referring now to the Konishi reference, it discloses a half-wave ($\lambda/2$) resonator having opposite ends that are open. However, the half-wave ($\lambda/2$) resonator disclosed in the Konishi reference is a TE₁₀ mode resonator. In contrast, the band pass filter recited in the claimed invention comprises a TEM mode resonator. Thus, the claimed invention has a configuration and operation that are patentably distinct from those of the Konishi reference. Accordingly, neither the Kundu et al. reference nor the Konishi reference, either alone or in combination, teach or suggest the claimed invention of the present application.

5. Claims Rejections – Double Patenting – Claims 5-9

Claims 5-9 are pending in the present application and were provisionally rejected in the Office action dated July 14, 2003 based on non-statutory, obviousness-type double patenting as being unpatentable over claims 7-9 of co-pending Application No. 10/000,602. Specifically, the Examiner states that claims 7-9 of the co-pending application include all the limitations of claims 5-9 of the present application, except that the claims of the co-pending application are more narrow. Thus, the Examiner concludes that claims 5-9 of the present application are anticipated.

Applicant respectfully traverses this rejection. However, claims 5-9 have been deleted. Thus, Applicant submits that the provisional rejection of claims 5-9, based on non-statutory obviousness-type double patenting, is now moot. Nevertheless, to the extent that the Examiner

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believes that this double patenting rejection might apply to new claim 17, Applicant provisionally responds to this rejection herein.

In claims 7-9 of co-pending Application No. 10/000,602, the band pass filter includes surfaces opposite to a shorting surface that are open. This limitation is not recited in the claimed invention of the present application. Accordingly, Applicant submits that at least for this reason, there should not be a non-statutory obviousness-type double patenting rejection made with respect to new claim 17.

6. Claims Rejections – Double Patenting – Claims 12-13

Claims 12-13 are pending in the present application and were provisionally rejected in the Office action dated July 14, 2003 based on non-statutory, obviousness-type double patenting as being unpatentable over claims 14-16 of co-pending Application No. 10/236,416, in view of Konishi. Specifically, the Examiner states that claims 14-16 of the co-pending application teaches the same structure as claims 12-13 of the present application, except that the claims of the co-pending application teach $\frac{1}{4}$ wavelength resonators, whereas the claimed invention teaches $\frac{1}{2}$ wavelength resonators. The Examiner then states that Konishi teaches that dielectric waveguide resonators can be made as $\frac{1}{4}$ wavelength by having an open end and a short circuit end or can be made as $\frac{1}{2}$ wavelength. The Examiner thereby concludes that claims 12-13 of the present application would have been obvious to one of ordinary skill in the art.

Applicant respectfully traverses this rejection. However, claims 12-13 have been deleted. Thus, Applicant submits that the provisional rejection of claims 12-13, based on non-statutory obviousness-type double patenting, is now moot. Nevertheless, to the extent that the Examiner believes that this double patenting rejection might apply to new claim 17, Applicant provisionally responds to this rejection herein.

Claims 12-13 of co-pending Application No. 10/000,602 disclose the use of $\frac{1}{4}$ wavelength resonators, whereas the claimed invention teaches the use of $\frac{1}{2}$ wavelength resonators. Furthermore, the shortcomings of the Konishi reference have been documented above in Section 4 of this response. Accordingly, Applicant submits that at least for this reason, there should not be a non-statutory obviousness-type double patenting rejection made with respect to new claim 17.

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CONCLUSION

Applicants have made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is clear that the differences between the claimed invention and the prior art are such that the claimed invention is patentably distinct over the prior art. Therefore, consideration and allowance of claims 1-5 is believed to be in order, and an early Notice of Allowance to this effect is respectfully requested. If the Examiner should have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8319. The undersigned attorney can normally be reached Monday through Friday from about 9:30 AM to 6:30 PM Pacific Time.

Respectfully submitted,

Dated: 10/14/03

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